Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte NED J. REO

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Appeal No. 1999-2242
Application No. 08/137,056

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ON BRIEF

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Before CALVERT, Administrative Patent Judge, MCCANDLISH, Senior Administrative Patent Judge, and GONZALES, Administrative Patent Judge.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 11 through 14. Claims 1 through 6 and 10 have been canceled. Claims 7 through 9, the only other claims in the application, stand withdrawn from consideration under 37 CFR § 1.142(b).

We AFFIRM.

The subject matter on appeal is directed to a windshield wiper (claims 11 and 14) and to a method of making a windshield wiper (claims 12 and 13). An understanding of the invention can be derived from a reading of exemplary claims 12 and 14, which are reproduced below.

12. A method of making a windshield wiper exhibiting a low coefficient of friction comprising a body portion and blade portion, which method comprises:

(1) providing a windshield wiper mold with at least a portion of its inside surface permanently coated with polytetrafluoroethylene,

(2)coating the permanent polytetrafluoroethylene coating on the inside surface of the mold of (1) with a transferable overcoat of polytetrafluoroethylene,

(3) placing a heat curable rubber mix into the mold,

(4) and molding the heat curable rubber mix.

14. A product produced by the method of claim 12.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Church	3,898,314	Aug. 05, 1975
Mohiuddin	4,350,739	Sep. 21, 1982
Yasukawa et al. (Yasukawa)	4,912,803	Apr. 03, 1990

Claims 11 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Yasukawa.[1,2]

Claims 12 through 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yasukawa in view of Church and Mohiuddin.

The full text of the examiner's rejections and response to the arguments presented by the appellant appears in the answer (Paper No. 20), while the complete statement of the appellant's arguments can be found in the main and reply briefs (Paper Nos. 19 and 21, respectively).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the

[1] The reference to canceled claims 2-4 in the examiner's statement of this ground of rejection (answer, p. 3) is an obvious inadvertent error.

[2] Technically, there is no antecedent basis for the language "the blade surface" in claim 11. For purposes of our review, we consider the quoted language to read --a surface of said blade portion--. Correction of this informality is in order upon return of the application to the jurisdiction of the examiner.

examiner. As a consequence of our review, we have made the determinations which follow.

The 35 U.S.C. § 102(b) rejection

Initially, we note that at page 5 of the main brief, the appellant has identified claims 11 through 14 as a single group and that the patentability of claims 11 and 14 has not been separately argued. Accordingly, we select claim 14 for review and claim 11 will stand or fall with representative claim 14. See 37 CFR § 1.192(c)(7).

Claim 14 is a product-by-process claim. The lack of physical description in a claim of this type makes the determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. As stated by the Court in In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972)

> . . . when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of

> processes put before it and then obtain prior art products and make physical comparisons therewith.

Yasukawa discloses a method of making a windshield wiper comprising (1) forming a starting article from a mixture of an elastomer, e.g., a natural or synthetic rubber (see col. 3, ll. 58-68), and a vulcanization agent, e.g., sulfur, (2) coating the starting article with a dispersion liquid comprising a mixture of elastomer, solvent, polytetrafluoroethylene (hereinafter "PTFE") (see col. 4, ll. 10 and 11 and col. 9, TABLE, Sample No. 6) and a vulcanization agent, (3) placing the coated starting article into a windshield wiper mold, and (4) vulcanizing the coated starting article by applying heat and pressure to the mold. See, e.g., col. 7, ll. 32 through col. 8, l. 17. Yasukawa teaches that the starting article may be coated with the dispersion liquid by dipping, brushing or spraying (see col. 7, ll. 3-10). Yasukawa also teaches that the elastomer used in the dispersion liquid may be any elastomer which is able to be bonded to the starting article (see col. 6, ll. 31-35).

The windshield wiper product produced by the method taught by Yasukawa comprises a base or body portion 82 and a lip or sliding portion 81 having a surface layer 51 made up of

more than 50% by volume of lubricant (e.g., PTFE) and being integrally bonded to the sliding portion 81 and is described as having excellent durability and a low coefficient of friction. See "Abstract."

The examiner determined (answer, p. 4) that Yasukawa discloses a product which reasonably appears to be identical with the product claimed in appealed claim 14. We agree. The end product of the method recited in appealed claim 12 is an elastomer windshield wiper having a PTFE coated blade portion. Likewise, the end product of the method disclosed by Yasukawa is an elastomer windshield wiper having a lip or sliding portion 81 with a surface layer 51 of PTFE. Thus, in our opinion, it was reasonable for the examiner to conclude that the prior art discloses a product which is identical with the product claimed in product-by-process claim 14.

Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to the appellant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710

F.2d 799, 803, 218 USPQ 289, 292-293 (Fed. Cir. 1983). Our review of the record reveals that the appellant has not advanced any objective evidence or compelling line of reasoning which establishes that there is a meaningful difference.

The only argument specifically directed to the 35 U.S.C. § 102 rejection of claims 11 and 14 is found at page 6 of the main brief, namely, that the appellant's windshield wiper is made by a one step molding of a heat curable rubber mixture which has
been surface treated prior to cure with a "transient release agent"[3] and does not require a subsequent integral press forming step to form the wiper.

Frankly, we are not certain what the appellant means by the language "one step molding" or how this language distinguishes the appellant's windshield wiper from the windshield wiper taught by Yasukawa. We remind the appellant that appealed claim 14 is directed to a windshield wiper,

[3] The reply brief (p. 2) clarifies that the "transient release agent" referred to in the main brief is the TEFLON or PTFE overcoat.

i.e., a product, not to a process of making a windshield wiper. Thus, even if differences do exist between the process recited in appealed claim 12 and the prior art process, it does not necessarily follow that differences exist between a product made by the process of appealed claim 12 and a product made by the prior art process.

The arguments presented in the main brief beginning on page 5 and continuing to page 6, line 13, are not directed to any
particular claim or rejection, but to the extent that they apply to the § 102(b) rejection of claims 11 and 14, the arguments are not persuasive.

The appellant first argues (main brief, p. 5) that there is no teaching in the cited references of a permanent TEFLON (PTFE) coating on the inside surface of the windshield wiper mold. We acknowledge, as does the examiner (see answer, p. 6), that Yasukawa does not teach a permanent PTFE coating on the inside surface of the windshield wiper mold illustrated in Figure 2. However, claim 14 is directed to a windshield wiper, not to a process of making a windshield wiper or to a mold used in such a process. Thus, even if differences do

exist between the process of making a windshield wiper or to the mold used in such a process, it does not necessarily follow that differences exist between a product made using a mold having a permanent PTFE coating on the inside surface thereof and a product made by the prior art process taught by Yasukawa.

The appellant next argues (main brief, p. 5) that he has found that enhanced penetration of a release agent into the surface of the wiper as it forms during molding can be achieved by having in place, prior to molding, an additional release agent between the surface of the permanent PTFE coating on the mold and the exterior surface of the uncured rubber mixture. However, the appellant has not identified this "enhanced penetration" as constituting a distinction over the applied prior art. Further, the appellant has not submitted any objective evidence to support the allegation regarding "enhanced penetration." In this regard, it is well settled that the arguments of counsel in a brief cannot take the place of evidence in the record. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

Finally, the appellant argues (main brief, p. 6) that Yasukawa's method for making the wiper blade requires the simultaneous cure of two separate and different EPDM mixtures. We disagree. The disclosed examples and preferred embodiments set forth in Yasukawa do not constitute the entire disclosure of the reference. As previously indicated, supra, Yasukawa also teaches that the elastomer present in the dispersion liquid may be any elastomer having the ability to be bonded to the starting article. Further, the presence of EPDM in the layer 51, which layer also includes more than 50% by volume of PTFE, does not distinguish the PTFE coating on the surface of the appellant's wiper blade portion from the layer 51 on the blade portion of Yasukawa's windshield wiper. Claim 12 calls for "a transferable
overcoat of polytetrafluoroethylene." The language is open-ended and includes within its scope overcoats of PTFE and other components, e.g., EPDM.

Accordingly, we will sustain the examiner's rejection of claim 14 under 35 U.S.C. § 102(b). Since claim 11 stands or falls with claim 14, supra, we will also sustain the

examiner's rejection of claim 11 under 35 U.S.C. § 102(b).

The 35 U.S.C. § 103(a) rejection

We have indicated above that we will sustain the examiner's rejection of claim 14 under 35 U.S.C. § 102(b) as being anticipated by Yasukawa. Thus, we find the examiner's use of the Church and Mohiuddin patents to be mere surplusage and sustain the § 103(a) rejection of claim 14 on the basis of Yasukawa alone, noting that anticipation or lack of novelty is the epitome of obviousness. Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

Claims 12 and 13 are grouped by the appellant with claim 14, supra. Accordingly, claims 12 and 13 fall with claim 14. See
37 CFR § 1.192(c)(7).

In addition, even if it is assumed for the sake of argument that claim 14 is not anticipated by Yasukawa, we have considered the collective teachings of Yasukawa, Church and

Mohiuddin and agree with the examiner that the invention set forth in claims 12 through 14 would have been obvious to one of ordinary skill in the art at the time of the appellant's invention.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The teachings of Yasukawa have been set forth above.

Church discloses a method of molding rubber articles in which the press components, e.g., the bottom surface 23 of plunger 7 and the interior walls of cavity 5, which contact an uncured rubber charge, are coated with TEFLON (PTFE) to provide a generally permanent non-sticking coating thereto. According to Church, the permanent PTFE coating eliminates the use of mold release material during each molding operation and its resultant cost and contamination of the rubber charge. See col. 6, ll. 17-28 and claim 4.

Mohiuddin discloses a method for producing a molded plastic part comprising a plastic substrate and a firmly

adherent coating thereon, which creates a smooth, unblemished, uniform and firmly adherent coating on the molded part and substantially reduces the number and cost of post-molding operations. See col. 1, ll. 48-58. The disclosed method includes the steps of coating the surface of a mold, prior to molding the plastic part, with a coating composition containing a reaction promoter for the reactive plastic molding material, introducing the reactive plastic molding material into the mold, the reaction promoter being present in an amount sufficient to transfer the coating composition from the mold surface and bond it to the substrate formed by the reactive molding material, molding the part and removing the part from the mold. Id. at ll. 25-36. Mohiuddin specifically teaches that the coating composition may be applied to the mold surface by spraying. See col. 2, ll. 2-5.

Based on our review of the applied prior art, it appears that the differences between the method recited in appealed claim 12 and that disclosed in Yasukawa are that Yasukawa's disclosed method does not include a permanent PTFE coating on

the inside surface of the windshield wiper mold and Yasukawa coats the starting material (corresponding to the "heat curable rubber mix" of claim 12) with the PTFE "overcoat," rather than the inner surface of the mold.

With regard to these differences, the examiner determined (answer, pp. 5 and 6) that

> [i]t would have been obvious . . . to provide the mold of Yasukawa with a permanent coating of TEFLON therein, as clearly suggested by Church, to provide permanent non-stick properties to the mold and thus eliminate possible sticking to the mold as well as eliminate the need for a spray release

and

> [i]t would have been obvious . . . to spray coat the modified mold of Yasukawa instead of dipping the body to be molded, as clearly suggested by Mohiuddin, to provide for a more uniform coating of the wiper blade.

The appellant argues (main brief, pages 7 and 8) that neither Church nor Mohiuddin would have suggested to the artisan the treatment of a permanent release coating (the claimed permanent PTFE coating) with an additional "transient release agent" (the claimed transferable overcoat of PTFE) prior to the introduction of the curable mixture into the mold.

We find the appellant's argument unpersuasive for the following reason. The appellant's argument is not based upon the rejection before us. Claim 12 has been rejected based on the combined teachings of Yasukawa, Church and Mohiuddin. The appellant has argued that claim 12 is not rendered obvious from the individual teachings of Church and Mohiuddin. The appellant has not provided any argument as to why the rejection under
35 U.S.C. § 103 before us in this appeal based upon the combined teachings of Yasukawa, Church and Mohiuddin is in error. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co., Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

For the reasons set forth above, we will sustain the examiner’s rejection of claims 12 through 14 under 35 U.S.C. § 103(a) as being unpatentable over Yasukawa in view of Church and Mohiuddin.

CONCLUSION

To summarize, the decision of the examiner to reject claims 11 and 14 under 35 U.S.C. § 102(b) is affirmed and the decision of the examiner to reject claims 12 through 14 under 35 U.S.C.

§ 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Ian A. Calvert Administrative Patent Judge	)	
Harrison E. McCandlish, Senior Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
John F. Gonzales Administrative Patent Judge	)	

JFG:tdl

Arlen L. Olsen
Schmeiser, Olsen & Watts
3 Lear Jet Lane, Suite 201
Latham, NY 12110